## REMARKS

All the claims submitted for examination have been rejected on formal and/or substantive grounds. Applicant has amended these claims and respectfully submits that all the claims currently in this application are patentable over the rejection of record.

Turning first to the formal grounds of rejection, Claims 14 and 21 stand rejected, under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Specifically, the recitation of "decabromodiphenyl" is deemed erroneous insofar at the Official Action argues that that term refers to a radical whereas that term is recited in the rejected claims as one of the compound members of a Markush group. As such, it is a compound.

Although applicant disagrees with this analysis, applicant has replaced the compound recited in Claims 14 and 21 with --decabromobiphenyl--. It goes without saying that the replacement term has a meaning limited to a compound.

It is emphasized that either term is acceptable since the two terms are synonyms for the compound. Therefore, the replacement term adds no new matter to the rejection. Applicant submits herewith page 44 of the Dictionary of Science wherein the terms biphenyl and diphenyl are both defined as synonymous terms for the compound having the formula $C_6H_5C_6H_5$. Obviously, that compound completely substituted by bromine atoms has an identical definition.

It is noted that Claim 28, which, presumably, due to an oversight, was not subject to this ground of rejection includes the same objected to term. Therefore, the same amendment has been made to that claim.

Reconsideration and removal of this ground of rejection is deemed appropriate. Such action is respectfully urged.

Two substantive grounds of rejection have been imposed in the outstanding Official Action. The first of these grounds is directed to all the claims currently in this application, Claims 14-23 and 26-28. Claims 14 to 23 and 26 to 28 stand rejected, under 35 U.S.C. §103(a), as being unpatentable over U.S. Patent 3,428,597 to Dikotter et al. in view of U.S. Patent 4,021,406 to Touval, U.S. Patent 5,859,176 to Nakahashi et al. or U.S. Patent 5,256,718 to Yamamoto et al.

The Official Action avers that Dikotter et al. discloses stabilization of polyamides wherein a complex compound of cuprous iodide and a hydrocarbon phosphine or hydrocarbon phosphite is employed as a stabilizer. Any one of the secondary Touval, Nakahashi et al. and Yamamoto et al. references is applied for their disclosure of a halogenated organic compound in polyamide compositions.

The Official Action concludes that the claimed polyamide composition and process of stabilizing a polyamide which employs at least one copper complex and at least one organic halogen compound is made obvious by the combined teaching of Dikotter et al. and Touval, Nakahashi et al. or Yamamoto et al.

Applicant has considered this ground of rejection and respectfully submits that the combined teaching of the applied references does not make obvious any of the claims currently in this application.

It is axiomatic that when references are combined to provide a combined teaching, as was done in the instant Official Action, the applied references must provide motivation to combine their teachings. Such motivation can be found in the prior art use of components in

compositions employed to provide the same results obtained by the polyamide composition of the present application or by the prior art use of additives to provide polyamides with the same properties as those obtained in the present application.

The polyamide composition of the present application is characterized by stabilization against the debilitating effects of embrittlement caused by heat aging but which is not subject to tracking. That is, the process of stabilizing polyamides and the stabilized polyamide composition claimed in the present application may be held unpatentable over the Official Action applied references only if they may combined to make obvious the novel composition and process of the present application.

Dikotter et al. discloses a stabilizer for polyamide compositions that protects against heat, light and air. However, there is no disclosure that the stabilizer of that reference provides tracking resistance.

The disclosures of the secondary references, although teaching the use of organic halogen compounds, do not so much as suggest their incorporation with a stabilizer polyamide composition to provide tracking resistance to an already stabilized polyamide composition. As such, none of the references combined with Dikotter et al., to allegedly make obvious the claims of the present application, would provide any motivation to one skilled in the art to combine any of their teachings with the teaching of Dikotter et al.

The first secondary reference, Touval, provides a flame retardant composition, by combining a halogen-containing organic compound with antimony oxide in combination with sulfur. Certainly, there is nothing in Touval that suggests the unique property of tracking resistance obtainable by utilizing an organic halogen compound with a composition providing polyamide stabilization, as taught by Dikotter et al.

The second secondary reference, Nakahashi et al., provides a polyamide composition which includes a polyphenylene ether, a styrene compound, a compound having a carbon to carbon double bond and at least one functional group selected from the group consisting of a carboxylic acid, an acid anhydride, an epoxy, an amino group and a hydroxyl group. Indeed, the only reason that this reference was even applied was because the styrene compound may be chlorine-modified. Certainly, this disclosure does not suggest its combination with Dikotter et al. to provide a stabilizer that provides good tracking resistance. It is furthermore emphasized that Nakahashi et al. is directed to a polyamide composition that makes no claim to providing aging stability or tracking resistance let alone both of these properties.

The last applied secondary reference, Yamamoto et al., discloses a polyamide composition that allegedly provides flame retardancy, moldability, color tone, heat stability and mechanical strength. However, like the other secondary references, no suggestion of combining the components of the Yamamato et al. composition with the components of Dikotter et al. stabilized polyamide composition to provide a composition that not only provides stabilization but tracking resistance as well, is made in the Yamamato et al. disclosure.

In summary, a plurality of stabilized polyamide compositions of the prior art are advanced. These compositions employ components long known in the art. However, none of them provide aging stability and tracking resistance. Therefore, there is no suggestion in the art to combine the randomly mentioned components, employed in various and sundry polyamide compositions, to produce a polyamide composition having stability against aging as well as tracking resistance. This observation is even more important in view of the fact

that prior to the invention of the present application a polyamide composition having excellent stabilization and tracking resistance characteristics was not known in the art.

Stated differently, the rejection of the outstanding Official Action employs a template created by the specification of the present application from which selected references, which in their broad disclosures include the claimed components of the present application, have been chosen. This selection of references, made without any rationale other than they provide the components required by the claims of the present application, is a danger to the patent system. The selection of references, exemplified by the rejection of the present application, forecloses advances of the type presented by the present application.

This selection of non-analogous references has been frown upon by the Federal Circuit in many decisions. That Court has held that references must be reasonably pertinent to the problem faced by the inventor. In re Clay, 966 F2d 656, 23 USPQ2d 1058 (Fed. Cir. 1992); In re Paulsen, 30 F.3d 1475, 31 USPQ2d 1671 (Fed. Cir. 1994); Wang Labs, Inc. v. Toshiba Corp., 993 F.2d 858, 26 USPQ2d 1767 (Fed. Cir. 1993). This requirement has not been met in the outstanding rejection. This ground of rejection should thus be reconsidered and rescinded.

The secondary substantive ground of rejection is also directed to all the claims submitted for examination in this application, Claims 14 to 23 and 26 to 28. This ground of rejection is identical to the first ground of rejection but for the substitution of the principal reference, Dikotter et al., with U.S. Patent 3,507,833 to Nentwig et al.

Nentwig et al. discloses a polyamide composition which includes copper and halogenated phosphite additives. However, halogenated phosphite additives are outside the definition of organic halogen compounds within the scope of the claims of the present

application. This second ground of rejection is thus very similar to the first ground of rejection, wherein the same three secondary references are applied, in the alternative, to provide an organic halogen compound to supplement the polyamide composition of the principal Nentwig et al. patent, which includes a copper compound, and thus provide a composition within the scope of Claims 14 to 23 and 26 to 28.

The arguments for patentability need not be repeated. Suffice it to say, the polyamide composition of Nentwig et al. is stated to provide heat and oxygen stabilization. No tracking resistance is alleged for the compositions within the contemplation of the Nentwig et al. disclosure. Thus, a halogenated organic compound, not present in the Nentwig et al. polyamide composition, which may be broadly and imperfectly mentioned in one of the secondary references, cannot be combined with Nentwig et al. to make obvious the claims subject to this second ground of rejection for the same reasons given in support of applicant's traverse of the first substantive ground of rejection.

It is emphasized that judicial notice should be taken of the granting of the corresponding application in Japan, wherein arguments of the type made above established patentability of the invention defined in the present application. Indeed, we have been informed that other examining nations, including Russia, China and Hungary, have indicated patentable subject matter of the claimed polyamide composition of the present invention. Reconsideration and removal of the substantive grounds of rejection, in view of the above remarks and actions by other examining nation, is therefore urged.

The above amendment and remarks establish the patentable nature of all the claims currently in this application. Notice of Allowance and passage to issue of all these claims,

Claims 14 to 27 and 26 to 28, is therefore respectfully solicited.

Respectfully submitted,

Marvin Bressler
Registration No. 25,132
Attorney for Applicants

Scully, Scott, Murphy & Presser
400 Garden City Plaza
Garden City, New York 11530
516-742-4343
MB:ml